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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,927	05/24/2000	Richard P. Welle	7413-1004	9473
23600	7590	04/05/2005	EXAMINER	
COUDERT BROTHERS LLP 333 SOUTH HOPE STREET 23RD FLOOR LOS ANGELES, CA 90071			HANIG, RICHARD E	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,927

Applicant(s)

WELLE, RICHARD P.

Examiner

Richard Hanig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-39 is/are rejected.
- 7) ☒ Claim(s) 26, 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/04 has been entered.

2. Applicant's response of March 22, 2002 to the Notice of Non-Compliant Amendment dated February 12, 2002 (paper #8) is still non-compliant. As stated in paper #8, and the final rejection of 04/20/04 the amendment does not comply with rule 37 CFR 1.173(d), which states in part "any changes relative to the patent being reissued which are made to the specification, including the claims ...". Therefore the amendment should not contain brackets. The claims are new with respect to the patent and are therefor underlined, and any amendment is made with respect to the patent not to respect to previous amendments, therefore the amended claim is written straight out and underlined with words left out if necessary without brackets. Also the status of the claims should be stated according to 37CFR 1.173 (c). The following action is being issued, however, failure to correct the amendment, the application will be abandoned.

3. Claims 25-39 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. V. Stein, Inc.*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F. 3d 1464, 45 USPQ2D 1161 (fED. CIR. 1997); *Ball Corp. v. United States*, 729 F. 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent.

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The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by filing of the present reissue application. Specifically, applicant can not acquire claims that are broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. The reissue claims' scope are narrower with respect to applicant's patent claims of a taggant method such as the use of a pen or in clothing, but broader with respect to using isotopic taggant or defining the specifics of the isotopic ratios that were argued in the rejection of the initial claims in the parent application. With respect to applicant's arguments, the claims were amended to include "wherein said abundance ratio being unchanged by chemical reactions", and very importantly, the applicant went out of their way to amend the first occurrence of the term "abundance" to being "isotopic abundance", and then on page 14 of the remarks section of amendment of 1/26/98 of application 08/668,648 the applicant argued that the references did not show the above quoted phrase. Also claims drawn to the use of taggants without the inclusion of isotopes is broader over the examiners reasons given for allowance, wherein the term (quoted from the amendment) "isotopic abundance" was specifically used and which the applicant has agreed to by not submitting any response to the examiners reasons for allowance.

The applicant has argued on page 13 that the term "isotopic" was implied in the context of the claim, and the inserted amendment phrase "wherein said abundance ratio being unchanged

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by chemical reactions” is an inherent property and was not needed for patentability. However, in the remarks on page 14 of amendment A in the parent application 08/668,648 (01/26/98) the applicant argues for patentability over the references based on the amended claims having the phrase “wherein said abundance ratio being unchanged by chemical reactions”. If that phrase had not been included then the examiner would have continued with the rejection, but instead, the phrase was used as the basis for the examiner’s reasons for allowance. The applicant has argued that there was no admission in the original prosecution that “non-isotopic” taggant subject matter was not patentable. But the subject matter that caused the invention to be patented was the content pertaining to isotopic taggants which the specification is drawn to and that every example listed in the specification is in reference to isotopic taggants which is also contained in the title of the patent, and one skilled in the art would not think that the patent had any other type of taggant other than an isotopic taggant. With respect to the Doyle citing, the MPEP discusses *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998) (claims to a sectional sofa comprising, inter alia, a console and a control means were held invalid for failing to satisfy the written description requirement where the claims were broadened by removing the location of the control means), and this is the same situation, the “non-isotopic” taggant methodology fails to satisfy the written description requirement.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25, 27-36, 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soberman et al (4,363,965) in view of Winnik et al (5271764) and Goldblatt et al (3788814). Soberman et al in col. 3, line 43 discuss using non-radioactive isotopes as taggants as identifiers in various compounds. In col. 7, line 45 they discuss using various isotopically enriched forms of the taggants. The reference does not disclose using the taggants in any type of marking procedure but Winnik et al describe the use taggants in ink jet ink for marking and encoding (see col.1, lines 6-10. It would have been obvious to one of ordinary skill in the art to put taggants and isotopic taggants in any type of marking system such as pens, paints, documents or clothing because as Winnik et al teach it can be done with ink jet ink and therefore any equivalent marking system. Soberman et al do not discuss various coding methods, the details of measuring the isotopic ratios or the correction for contaminants. The coding method is an obvious step one would make to associate and identify a taggant with a substance. Goldblatt et al (col.2) discuss the measuring of isotopic ratios and shows that it is well known, and the method used to extract the relevant information would also have a procedure for accounting for contaminants because this is a standard problem that is handled in analytical chemistry. It would have been obvious to one skilled in the art to use Goldblatt et al in Soberman et al and Winnik et al because these are the standard techniques that are used to get isotopic ratios and make corrections for contaminants which give accuracy to the method. With respect to applicant's arguments that Soberman et al do not mark items with taggants, that they are just used in compositions; and Winnik et al's procedure contain no coding information, the examiner points to the following sections of their respective patents. Soberman et al in col. 1, lines 14-15 contemplate using their invention on tax stamps and currency which imply the use of taggants in ink. Winnik et al is used for their

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manifest suggestion of using taggants in ink. They discuss a system of taggants that contain coded information (see col. 3, lines 54-60), and in col. 8, lines 7-30, they describe using dyes that give information because they fluoresce in different wavelengths, and their examples show different intensity ratios at different wavelengths. Therefore, Winnik et al has the manifest suggestion to use taggant inks for identification, and the type of taggants is immaterial. In reference to applicant's arguments, solid particles can be encapsulated and be in an ink and used as an identifier.

5. Claims 26, 37 are dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims wherein the base claim must be limited to isotopic taggants.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Hanig whose telephone number is 571-272-2329. The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RA
03/28/05


Georgia Epps
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